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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER AIRAPETIAN, MILA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,928	<b>Applicant(s)</b> YAMANOUE ET AL.	
	<b>Examiner</b> Mila Airapetian	<b>Art Unit</b> 3625	

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/14/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 2, 4, 6, 8, 9, 10, 11, 12, 18, 19 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Berstis et al. (hereinafter Berstis) (US 6,282,653).**

#### **Regarding claim 1,**

Berstis teaches royalty collection system for use of copyrighted digital materials on the internet comprising:

a manipulation unit for selection of a desired electronic copyrighted work (col. 11, lines 37-62);

a copyright royalty information storage unit storing copyright royalty information of an electronic copyrighted work (col. 8, lines 8-10; lines 21-26),

a copyrighted work data storage unit storing electronic copyrighted work data (col. 6, lines 36-42),

a copyright royalty calculation unit calculating a copyright royalty of an electronic copyrighted work selected through said manipulation unit based on the copyright royalty information stored in said copyright royalty information storage unit (col. 5, lines 51-63, lines 36-49),

a communication unit transmitting to an external source the copyright royalty calculated by said copyright royalty calculation unit (col. 8, lines 8-17), and

a copyrighted work data write unit writing into a recording medium electronic copyrighted work data corresponding to the electronic copyrighted work selected through said manipulation unit out from electronic copyrighted work data stored in said copyrighted work data storage unit (col. 5, lines 19-21, lines 25-26).

**Regarding claim 2,** Berstis further teaches said further comprising a sales information recording unit recording sales status of a relevant electronic copyrighted work sales apparatus (col. 9, lines 50-53).

**Regarding claim 4,** Berstis further teaches said apparatus wherein said sales information control unit reads out the sales status recorded in said sales information recording unit by reading out and executing a portion of a program corresponding to the identification information stored in said identification information storage unit and a remaining portion of said program recorded in said sales information readout card (col. 9, lines 24-45).

**Regarding claim 6,** all the limitations of claim 6 are covered and analyzed in claim 4 above.

**Regarding claim 8,**

Berstis teaches royalty collection system for use of copyrighted digital materials on the internet comprising:

a communication unit receiving from an external source copyright royalty data of an electronic copyrighted work sold (col. 7, lines 3-12),

a copyright information storage unit storing copyright information of an electronic copyrighted work to be sold (col. 6, lines 36-42), and

a copyright royalty data storage unit storing for each copyright holder copyright royalty data received by said communication unit according to the copyright information stored in said copyright information storage unit (col. 8, lines 8-10; lines 21-26).

**Regarding claim 9**, said system further comprising a copyright royalty data approval processing unit causing said communication unit to transmit to an external source copyright royalty data recorded in said copyright royalty data recording unit when copyright royalty data stored in said copyright royalty data storage unit is approved (*"control routine remainder of the account is then distributed to the content provider"*; col. 8, lines 21-28).

**Regarding claim 10**, Berstis further teaches a system comprising:

an electronic copyrighted work sales apparatus selling an electronic copyrighted work (col. 2, lines 37-46, lines 63-67),

a copyright management apparatus (central authority) administering a copyright royalty of an electronic copyrighted work sold by said electronic copyrighted work sales apparatus (col. 10, lines 2-7),

a seller terminal used by a seller (col. 7, line 1-3) and

a copyright holder terminal used by a copyright holder (col. 8, lines 14-25; indicates a holder terminal for transmitting copyrighted files to the seller (source terminal), wherein said electronic copyrighted work sales apparatus includes a manipulation unit for selection of a desired electronic copyrighted work (col. 11, lines 37-62),

a copyright royalty information storage unit storing copyright royalty information of an electronic copyrighted work (col. 8, lines 15-28),

a copyrighted work data storage unit storing electronic copyrighted work data (col. 7, line 3),

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a copyright royalty calculation unit calculating a copyright royalty of an electronic copyrighted work selected through said manipulation unit according to the copyright royalty information stored in said copyright royalty information storage unit (col. 5, lines 36-49, 51-63),

a first communication unit transmitting to said copyright management apparatus (central authority) the copyright royalty calculated by said copyright royalty calculation unit (col. 10, lines 2-7; means for notifying the central authority), and

a copyrighted work data write unit writing into a recording medium electronic copyrighted work data corresponding to the electronic copyrighted work selected through said manipulation unit out from electronic copyrighted work data stored in said copyrighted work data storage unit (col. 5, lines 19-21; lines 25-26),

wherein said copyright management apparatus includes a second communication unit receiving from said copyrighted work sales apparatus copyright royalty data of an electronic copyrighted work sold (col. 10, lines 2-7; notifying the central authority indicates providing communication means for the central authority),

a copyright information storage unit storing copyright information of an electronic copyrighted work to be sold (col. 6, lines 36-42),

a copyright royalty data storage unit storing for each copyright holder copyright royalty data received by said second communication unit according to the copyright information stored in said copyright information storage unit (col. 8, lines 8-10, lines 21-26), and

a copyright royalty data approval processing unit causing said second communication unit to transmit copyright royalty data recorded in said copyright royalty data storage unit to said seller terminal when the copyright royalty data stored in said copyright royalty data storage unit is approved from said copyright terminal (col. 9, lines 21-26).

**Regarding claim 11**, Berstis further teaches a system comprising:

a communication unit carrying out data communication with an external source (Fig. 4 (40)),

a user interface for a user to select desired contents (col. 4, lines 53-55),

a storage unit storing contents of an electronic book and a contents identifier in correspondence (Fig. 7 (206), col. 12, .lines 1),

a communication port to which a user identifier is input, and a processing unit extracting from said storage unit a contents identifier corresponding to the contents selected by said user interface, causing said communication unit to transmit said contents identifier and the user identifier input through said communication port to said external source, and providing in a pair auxiliary information to display contents received by said communication unit and the contents of an electronic book selected by said user interface (Fig. 7 (102), col. 11, lines 64-65).

**Regarding claim 12**, Berstis further teaches said apparatus further comprising a charge account processing unit carrying out charge accounting from a user, wherein said processing unit alters the contents identifier transmitted by said communication unit according to charge account status by said charge account processing unit (col. 9, lines 24-27).

**Regarding claim 18**, Berstis further teaches said apparatus further comprising a recording medium in which auxiliary information to display contents and encoded contents of an electronic book are recorded, wherein said input unit reads out the auxiliary information and the encoded contents of an electronic book recorded in said recording medium (col. 11, lines 64-65).

**Regarding claim 19**, Berstis further teaches said apparatus wherein said recording medium has said auxiliary information recorded in a nonreadable region (col. 11, lines 64-65).

**Regarding claim 21**, Berstis teaches a secure communications system that permits downloading of copyrighted materials comprising a processing unit generating and adding to electronic book data auxiliary information according to the electronic book data and an input user identifier (Fig. 3).

**Claims 13, 14, 15, 16, 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Sachs et al. (hereinafter Sachs) (US 5,956,034).**

**Regarding claim 13**, Sachs teaches a secure communications system that permits downloading of copyrighted materials comprising:

a communication unit carrying out data communication with an external source (Fig. 1, col. 1, lines 42-44),

a first table storing in correspondence a contents identifier corresponding to contents of an electronic book and a contents key (Fig. 1 (18), col. 3, line 4),

a second table storing in correspondence a user identifier and a user key (Abstract), and

a processing unit referring to said first table and said second table to extract a contents key and a user key according to the contents identifier and user identifier received by said communication unit, and generating and causing said communication unit to transmit auxiliary information to display contents from said extracted contents key and user key (col. 4, lines 29).

**Regarding claim 14**, Sachs teaches a secure communications system that permits downloading of copyrighted materials comprising:

an input unit to enter auxiliary information to display contents and encoded contents of an electronic book (Fig. 5 A (S 204),



a processing unit generating a contents key from the auxiliary information input by said input unit and a prestored user key, and reproducing encoded contents input by said input unit using said contents key (col.3, lines 45-47), and

a display unit displaying the contents reproduced by said processing unit (Fig. 2A, col. 3, line 7).

**Regarding claim 15**, said apparatus wherein said encoded contents include a plurality of modules including at least one of data and a processing program, wherein said processing unit sequentially executes said plurality of modules and reproduces said electronic book contents (col. 4, lines 28-29, 31-38).

**Regarding claim 16**, said apparatus wherein said plurality of modules includes a module with a description of display attribute information, wherein said processing unit extracts a display attribute from said module with description of a display attribute, and selectively executes said plurality of modules according to said display attribute (col. 4, lines 36-38).

**Regarding claim 17**, said apparatus wherein said plurality of modules include a module with a description of information indicating the type of contents key, wherein said processing unit extracts information indicating the type of contents key from said module with a description of information indicating the type of contents key, and determines whether to execute or not said module according to said information (col. 3, lines 45-47).

**Regarding claim 20**, Sachs teaches a secure communications system that permits downloading of copyrighted materials comprising:

an electronic copyrighted work sales apparatus selling an electronic book (Fig. 4D),

a key information management apparatus administering key information of an electronic book that is to be sold by said electronic copyrighted work sales apparatus (Abstract, col. 3, lines 36-49), and

an electronic book display apparatus reproducing and displaying an electronic book sold by said electronic copyrighted work sales apparatus (Fig 2A, col. 4, lines 3-4), wherein said electronic copyrighted work sales apparatus includes

a first communication unit carrying out data communication with said key information management apparatus (col. 1, lines 52-55);

a user interface for a user to select desired contents (Fig. 4D, col. 5, lines 5-7),

a storage unit storing in correspondence contents of an electronic book and a contents identifier (Fig. 1 (18), col. 3, line 4),

a communication port to which a user identifier is input, and a first processing unit extracting from said storage unit a contents identifier corresponding to the contents selected by said user interface, transmitting by said first communication unit said contents identifier and the user identifier input by said communication port, and providing auxiliary information to display contents received by said first communication unit and contents of an electronic book selected by said user interface in a pair (col. 1, lines 52-55), wherein said key information management apparatus includes

a first table storing in correspondence a contents identifier and a contents key corresponding to contents of an electronic book (Fig. 1 (18), col. 3, lines 4),

a second table storing in correspondence a user identifier and a user key (Abstract, col. 3, lines 36-49), and

a second processing unit referring to said first table and said second table to extract a contents key and user key according to the contents identifier and user identifier received by said second communication unit, and generating auxiliary information to display contents from said extracted contents key and user key and

causing said second communication unit to transmit said auxiliary information (col. 4, lines 36-38) wherein said electronic book display apparatus includes

an input unit to input auxiliary information to display said contents and encoded contents of an electronic book (Fig. 2A (63), col. 5, lines 18-20),

a third processing unit generating a contents key from auxiliary information input by said input unit and a prestored user key, and reproducing encoded contents input through said input unit using said contents key (col. 4, lines 36-38), and

a display unit (308) displaying contents reproduced by said third processing unit (Fig. 2A, col. 5, line 13).

**Claim 7 is rejected under 35 U.S.C. 103(e) as being unpatentable over Berstis in view of Official notice.**

**Regarding claim 7**, Berstis further teaches said system further comprising a recording media storage unit (col. 5, lines 19-21, lines 25-26).

Berstis teaches that said digital files can be stored on a hard drive. Berstis does not specifically teach that said hard drive comprises a plurality of recording media. Official Notice is taken that it is old and well known that hard drives are partitioned into a plurality of independent segments for storing different files. Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Berstis to include that hard drives comprises a plurality of segments because dividing the hard drive into multiple partitions would improve performance and simplify backups.

**Claim 22 is rejected under 35 U.S.C. 103(e) as being unpatentable over Sachs et al. (US 5,956,034) in view of Gilberston et al. (US 5,404,518)**

**Regarding claim 22**, Sachs et al. teaches said system including processing unit configured for:

carrying out a process according to information defined in a header of input electronic book data and applying the result to electronic book data to be output (Fig. 2B (80), col. 4, line 37),

encrypting a portion of input electronic book data, and adding the encrypted data to electronic book data to be output (col. 5, lines 5-6), and

receiving transaction specific information (col. 11, lines 4-9).

Sachs et al. does not specifically teach that said received transaction specific information includes receiving a user identifier.

Gilberston et al. teach a system for remote retrieving of documents, including a processor configured for accessing a user identifier for receiving and storing identities of authorized users of the system and for identifying the identity of the user for whom the document is being retrieved from the database structure according to the search instructions (col. 7, lines 9-14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sachs et al. to include that said received transaction specific information includes receiving a user identifier, as disclosed in Gilberston, because it would advantageously allow to enhance the security of the system by preventing an access to said system by unauthorized users.

Also, Sachs et al. in view of Gilberston do not specifically teach that said processor (unit) includes a first, a second and a third processing units for performing said functionalities. It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify Sachs et al. in view of Gilberston to include that said processor (unit) includes a first, a second and a third processing units, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

**Claim 23, 25 and 26 are rejected under 35 U.S.C. 103(e) as being unpatentable over Berstis in view of Sachs et al. (US 5,956,034).**

**Regarding claim 23,** Berstis teaches said system comprising a first processing unit generating auxiliary information according to electronic book data and a user identifier (account), and comparing said generated auxiliary information and auxiliary information added to said electronic book data (comparison of the user's account balance and the royalty amount to be assessed (col. 9, lines 24-26), a reproduction processing unit determining a reproduction processing method of contents according to a comparison result by said first processing unit and reproducing the contents (col. 9, lines 25-43).

Berstis does not specifically teach that said copyrighted digital materials include an electronic book.

Sachs teaches a secure communications system that permits downloading of copyrighted materials, wherein said copyrighted materials includes an electronic book (Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Berstis to include that said copyrighted digital materials include an electronic book, as disclosed in Sachs, because it would advantageously increase the application field of the invention, thereby potentially increase revenue.

**Regarding claim 25,** Berstis further teaches said system further comprising a third processing unit determining whether to decode or not an encrypted portion of said electronic book data according to a comparison result by said first processing unit and carrying out a process (col. 7, lines 46-52).

**Regarding claim 26,** Berstis further teaches said apparatus comprising a user identifier registration unit registering a user identifier that is automatically generated or input by a user (col.8, lines 21-29).

**Claim 24 is rejected under 35 U.S.C. 103(e) as being unpatentable over Berstis in view of Sachs et al. and further in view of Saito (US 2002/0021807).**

**Regarding claim 24,** The combination of Berstis and Sachs teaches all the limitations of claim 24 except that said apparatus further comprising a second processing unit comparing usage time limit information defined in a header of said electronic book data with the current time to determine whether to display contents or not and outputting a designation to said reproduction processing unit.

Saito teaches a system for controlling database copyrights including limiting the number of usage times [0033].

It would have been obvious to one having ordinary skills in the art at the time the invention was made to modify the combination of Berstis and Sachs to include comparing usage time limit information defined in a header of said electronic book data with the current time to determine, as disclosed in Saito, because on the basis of this comparison, if the utilization time has expired downloading of the book would be prevented.

**Claims 3 and 5 are rejected under 35 U.S.C. 102(e) as being unpatentable over Berstis in view of Schelberg et al. (US 2004/0190694).**

**Regarding claim 3,** Berstis further teaches said apparatus further comprising an identification information storage unit storing identification information of an electronic copyrighted work sales apparatus (col. 3, lines 65-66).

However Berstis does not teach a sales information control unit sensing attachment of a sales information readout card corresponding to the identification information stored in said identification information storage unit, and reading out sales status recorded in said sales information recording unit.

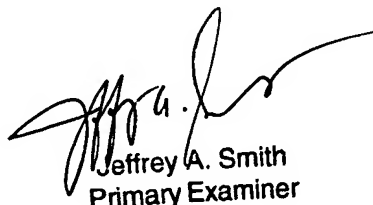
Schelberg teaches a vending machine for dispensing telecommunications access wherein the payment processing unit accept payment by smart card [0052].

**Regarding claim 5**, all limitations of claim 5 are covered and analyzed in claim 3 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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